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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DANIEL J. BARRETT, DANIEL Y. CHEN,  
and ROBERT W. LEE

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Appeal 2015-001674<sup>1</sup>  
Application 11/207,473<sup>2</sup>  
Technology Center 3600

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Before ANTON W. FETTING, NINA L. MEDLOCK, and  
BRUCE T. WIEDER, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 3, 5–11, 13, and 15–26. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> Our decision references Appellants' Appeal Brief ("App. Br.," filed September 15, 2014) and Reply Brief ("Reply Br.," filed November 24, 2014), and the Examiner's Answer ("Ans.," mailed October 8, 2014) and Final Office Action ("Final Act.," mailed April 14, 2014).

<sup>2</sup> Appellants identify The United States Postal Service as the real party in interest. App. Br. 3.

## CLAIMED INVENTION

Appellants' claimed invention "relates to a printed postage container, and more particularly, to a printed postage container having integrated security features for transporting an article for delivery" (Spec. ¶ 2).

Claims 1, 11, and 23 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A container, comprising:
  - pre-paid postage printed on the container prior to providing the container to a sender, the postage being visually perceivable by a human from all viewing angles with respect to a surface of the container; and
  - a multi-level security element, comprising:
    - a pseudo-latent image comprising a plurality of letters forming a word, the pseudo-latent image formed on the surface of the container at a first location and being visually perceivable by a human from fewer than all viewing angles with respect to the surface of the container; and
    - an encoded design comprising a version of the pseudo-latent image comprising a misspelling of the word, the misspelling of the word being according to a verification code indicating an authenticated misspelling of the word, and the encoded design formed on the surface of the container at a second location different from the first location and being visually perceivable by a human,
  - wherein, based on the verification code, the visually perceivable encoded design is compared to the visually perceivable pseudo-latent image in order to authenticate the container.

## REJECTIONS

Claims 1, 3, 5, 9–11, 13, 15, and 19–26 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gunther (US 2003/0080182 A1, pub. May 1, 2003), Applebaum (US 2003/0140015 A1, pub. July 24, 2003), Coe (US 5,468,581, iss. Nov. 21, 1995), Phillips (US 6,692,030 B1, iss. Feb. 17, 2004), and Cortina (US 2004/0066273 A1, pub. Apr. 8, 2004).

Claims 6, 7, 16, and 17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gunther, Applebaum, Coe, Phillips, Cortina, and Connell (US 5,554,842, iss. Sept. 10, 1996).

Claims 8 and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gunther, Applebaum, Coe, Phillips, Cortina, and Parkos (US 5,912,682, iss. June 15, 1999).

## ANALYSIS

### *Independent Claim 1 and Dependent Claims 3, 5, 9, 10, and 24*

We are persuaded that the Examiner has failed to establish a prima facie case of obviousness. In rejecting independent claim 1 under 35 U.S.C. § 103(a), the Examiner cites Gunther as disclosing a container, i.e., an envelope, with pre-paid postage visually perceivable from all viewing angles (Final Act. 3). However, the Examiner acknowledges that Gunther does not disclose a security element on the container, and cites the combination of Applebaum, Coe, Phillips, and Cortina as disclosing and/or suggesting a multi-level security element comprising

a pseudo-latent image comprising a plurality of letters forming a word, the pseudo-latent image formed on the surface of the container at a first location and being visually perceivable by a human from fewer than all

viewing angles with respect to the surface of the container;  
and  
an encoded design comprising a version of the pseudo-latent image comprising a misspelling of the word, the misspelling of the word being according to a verification code indicating an authenticated misspelling of the word, and the encoded design formed on the surface of the container at a second location different from the first location and being visually perceivable by a human,

as recited in claim 1. In this regard, the Examiner cites (1) Applebaum as disclosing that envelopes may include a plurality of security measures, such as watermarks, i.e., a multi-level security element (*id.* at 4 (citing Applebaum ¶¶ 226, 237)); (2) Coe as disclosing a security watermark, i.e., a latent image, that is only visible at certain angles to the human eye (*id.* (citing Coe, Figs. 2 and 3; col. 1, ll. 27–30 and 56–59)); (3) Phillips as disclosing that a watermark may include a series of words and that, within the series, a particular word may be intentionally modified (*id.* (citing Phillips, Figs. 11, 13; col. 7, ll. 31–46; col. 8, l. 52–col. 9, l. 9)); and (4) Cortina as disclosing that intentional modifications to watermark words include intentional misspellings (*id.* (citing Cortina ¶¶ 41–42)).

The Examiner maintains that it would have been obvious at the time of Appellants' invention to combine the features of Applebaum, Coe, Phillips, and Cortina to arrive at a multi-level security element, as called for in claim 1 (*id.* at 4–5; *see also* Ans. 2–4). But the Examiner does not adequately explain how, and we fail to see how, the combination of Applebaum, Coe, Phillips, and Cortina discloses or suggests “a pseudo-latent image comprising a plurality of letters forming a word . . . formed on the surface of the container at a first location” and “an encoded design comprising a version of the pseudo-latent image . . . formed on the surface of

the container at a second location different from the first location,” as recited in claim 1.

The Examiner cites Phillips as disclosing a watermark that includes a plurality of words (*see* Ans. 2). However, as Appellants correctly observe, Phillips fails to disclose or suggest a pseudo-latent image at a first location and an encoded design comprising a version of the pseudo-latent image at a second location different from the first location (App. Br. 12).

Phillips discloses a counterfeit-resistant document comprising a substrate and a nano-pattern of nano-structures disposed on the substrate; the nano-pattern forms one of a foreground and a background of a latent message and another pattern, e.g., a conventional pattern or another nano-pattern, forms the other of the foreground and background of the latent message; the foreground and background exhibit substantially similar visual densities on an original document, and exhibit substantially different visual densities on the copied document (Phillips, Abstract). The nano-pattern and the other pattern, as disclosed in Phillips, are overlaid at the *same* location on the substrate, i.e., not at a first location and a second location different from the first location, to form a latent image that appears on a copy of the document (*see id.* at col. 3, ll. 9–32).

Responding to Appellants’ argument that Phillips does not disclose or suggest a pseudo-latent image at a first location and an encoded design comprising a version of the pseudo-latent image at a second location different from the first location, the Examiner asserts that “Phillips was never cited for the nano-pattern/substrate concept” but instead was cited “for the particular design of the security mark, which includes a plurality of words in a plurality of locations” (Ans. 3–4). But the Examiner does not

otherwise explain how the combination of Applebaum, Coe, Phillips, and Cortina discloses and/or suggests the argued feature.

The Examiner has failed, on the present record, to establish a prima facie case of obviousness. Therefore, we do not sustain the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the rejection of dependent claims 3, 5, 9, 10, and 24. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("dependent claims are nonobvious if the independent claims from which they depend are nonobvious").

*Independent Claims 11 and 23 and Dependent Claims 13, 15, 19–22, 25, and 26*

Independent claims 11 and 23 include language substantially similar to the language of claim 1 and stand rejected based on the same rationale applied with respect to claim 1 (Final Act. 3–7). Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of independent claims 11 and 23, and claims 13, 15, 19–22, 25, and 26, which depend therefrom, for the same reasons set forth with respect to claim 1.

*Dependent Claims 6–8 and 16–18*

Claims 6–8 and 16–18 depend from claims 1 and 11, respectively. The Examiner's rejections of these dependent claims do not cure the deficiency in the Examiner's rejection of independent claims 1 and 11. Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of claims 6–8 and 16–18 for the same reasons set forth with respect to the independent claims from which they depend.

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DECISION

The Examiner's rejections of claims 1, 3, 5–11, 13, and 15–26 under 35 U.S.C. § 103(a) are reversed.

REVERSED